



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Pokempner et al.

Serial No.: 10/733,828

Group No.: 3714

Filed: Dec. 11, 2003

Examiner: U. Cegielnik

For: ACTIVITY KIT, PARTICULARLY FOR CHILDREN AND YOUNG ADULTS

APPELLANTS' BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real parties and interests in this case are Joshua Pokempner, Jonathan Wright, and Kellie Hebert, Applicants and Appellants.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 15 claims. Claims 16-72 were added by amendment in August 2004. Claim 5 has canceled. Claims 1-4 and 6-72 are pending, rejected and under appeal. Claims 1, 16, 30, 44 and 57 are the independent claims.

IV. Status of Amendments Filed Subsequent to Final Rejection

No after-final amendments have been filed.

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V. Summary of Claimed Subject Matter

Independent claim 1 resides in an activity kit, comprising a box 102, 202 for holding a set of writing implements 103, 203 or other materials including rubber stamps, ink pads, playing cards or flash cards, stickers or temporary tattoos. The box has front, back and side panels defining two front edges and two back edges, and a pad of paper 104, 204 or book having a separate back panel 120, 220 hinged to the box in a manner allowing the pad or book and box to fold against one another in overlying registration. (Specification, page 2, lines 10 to page 3, line 5; Figures 1 and 2)

Independent claim 16 resides in an activity kit, comprising a box 102, 202 for holding a set of writing implements 103, 203 or other materials, and a pad of paper 104, 204 or book including preprinted indicia in the form of a coloring book, activity book, games, or puzzles. The pad or book has a back panel hinged to the box in a manner allowing the pad or book and box to fold against one another in overlying registration. (Specification, page 2, lines 10 to page 3, line 11; Figures 1 and 2)

Independent claim 30 resides in an activity kit, comprising a box 102, 202 for holding a set of writing implements 103, 203 or other materials. A pad of paper 104, 204 or book has a back panel 120, 220 hinged to the box in a manner allowing the pad and box to fold against one another in overlying registration. A handle 130, 132 is provided on one or both of the box and back panel of the pad. (Specification, page 2, lines 10 to page 3, line 5; Figures 1 and 2)

Independent claim 44 resides in an activity kit, comprising a box 102, 202 for holding a set of writing implements 103, 203 or other materials and a pad of paper 104, 204 or book having a back panel 120, 220 hinged to the box in a manner allowing the pad and box to fold against one another in overlying registration. Handles 130, 132 are provided on both the box and back panel of the pad or book, each handle having a through-hole which is aligned with the other when folded against one another in overlying registration. (Specification, page 2, lines 10 to page 3, line 5; Figures 1 and 2)

Independent claim 57 resides in an activity kit, comprising a box 102, 202 for holding a set of writing implements 103, 203 or other materials, the box having front, back and side panels defining two front edges and two back edges, and a pad of paper 104, 204 or book having a back panel 120, 220 hinged to one of the back or front edges of the box such that the box and pad are side by side when unfolded. (Specification, page 2, lines 10 to page 3, line 5; Figures 1 and 2)

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 57-60, 62-64 and 67-71 under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,388,689 to Kroop et al.

B. The rejection of claims 1-4, 6-8, 11-22, 25-29 and 61 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,388,689 to Kroop et al. in view of U.S. Patent No. 6,164,976 to Wilson.

C. The rejection of claims 9, 10, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,388,689 to Kroop et al. in view of U.S. Patent No. 6,164,976 to Wilson, and further in view of U.S. Patent No. 5,671,951 to Palmiter et al.

D. The rejection of claims 30-33, 35-47, 49-56, 65 and 66 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,388,689 to Kroop et al. in view of U.S. Patent No. 5,671,951 to Palmiter et al.

E. The rejection of claims 34 and 48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,388,689 to Kroop et al. in view of U.S. Patent No. 5,671,951 to Palmiter et al., and further in view of U.S. Patent No. 6,164,976 to Wilson.

VII. Argument

A. Claims 57-60, 62-64 and 67-71

Claims 57-60, 62-64 and 68-71 stand rejected under 35 U.S.C. 112(b) over Kroop et al. However, it is well settled that anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

In this case, the independent claim of this group, claim 57, includes the limitations of a box having front, back and side panels defining two front and two back edges, and a pad of paper having a separate back panel hinged to one of these edges. Referring to Kroop et al., it is clear that what the Examiner is calling a "box" actually only has back and side panels, and does *not* include a front panel.

The Examiner makes no mention of this deficiency, and the lack of this element clearly defeats *prima facie* anticipation. Indeed, a point of novelty of the Kroop invention is that the pads of paper be folded onto the box, thereby forming a multi-layer "front panel" that otherwise did not exist. This is shown in all of the embodiments of the Kroop invention, including the triangular configuration of Figure 9, and the circular configuration of Figure 10. Given that the Kroop reference does not include a box with a front panel, anticipation has not been established, and all of the claims of this group should be deemed allowable.

B. Claims 1-4, 6-8, 11-22, 25-29 and 61

Claims 1-4, 6-8, 11-22, 25-29 and 61 stand rejected under 35 U.S.C. 103(a) over Kroop et al. in view of Wilson ('976). Claim 1 includes some of the limitations of previously argued claim 57, namely, a box having front, back and side panels defined and two front edges and two back edges. By virtue of this combination of elements, even if the Kroop/Wilson combination were justified, Appellants' invention as now claimed would not result. Accordingly, *prima facie* obviousness has not been established.

C. Claims 9, 10, 23 and 24

Claims 9, 10, 23 and 24 stand rejected under 35 U.S.C. §103(a) over the references applied to claims 1 and 16, and further in view of Palmiter. These claims include the limitation of a handle on one or both of the box and the back panel of the pad. The Examiner concedes that Kroop et al. as modified by Wilson lacks this feature, but attempts to import the teachings of Palmiter to address the deficiency. However, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Appellants' claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is no teaching or suggestion from the prior art to provide handles with through-holes as taught by Palmiter et al. to the Kroop et al. article and, indeed, it is impossible to ascertain where such handles would go. Given the invention of Kroop et al., and its point of novelty with multiple overlapping panels, it would be impossible to ascertain where such a handle would be placed on the structure and indeed, if a through-hole were formed, it might extend through the kit itself, thereby rendering the article unfit for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The argument that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

D. Claims 30-33, 35-47, 49-56, 65 and 66

Claims 30-33, 35-47, 49-56, 65 and 66 stand rejected under 35 U.S.C. §103(a) Kroop et al. in view of Palmiter et al. While conceding that Kroop et al. do not teach a handle, the Examiner contends that this would be an obvious modification as it “would allow the portable receptacle to be carried or transported easily.” This is pure speculation, since the kit of Kroop et al. is *already* “easy to carry.” Moreover, given the novel method of folding the kit of Kroop, it would be impossible to ascertain where such a handle should go.

“One skilled in the art [sic] will appreciate that, where the kit contains four wings, there are thirty-six partially open positions and twenty-four closed positions possible. This multitude of positions results from the possible permutations of open and closed wings. For example, to obtain a closed position, wing 22 may be first be folded over external wall 40 and base 11 to cover base 11. If wings 24, 26, and 28 are subsequently folded over external wall 40 and base 11, the wings will then be in a closed position. A second closed position may be obtained by first folding wing 22, then folding wings 26, 24, and 28 in respective order. This multiplicity of positions has the advantage of allowing the user to experiment with the various permutations, thus further preventing the user from becoming bored. If one of the wings 22, 24, 26, 28 has a logo or other writing designed to be viewed when the wings have been

folded into a closed position, then preferably that wing is to be folded over external wall 40 and base 11 after all other wings have been so folded. (Kroop, 7:40-59)

Thus, the Examiner's proposed inclusion of a handle could preclude the foldability of the Kroop invention, rendering it unfit for its intended purpose. As such, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The argument that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

E. Claims 34 and 48

Claims 34 and 48 stand rejected under 35 U.S.C. §103(a) over the references applied to claim 30, and further in view of Wilson. These claims include the limitation of other materials, such as rubber stamps, ink pads, playing cards or flashcards, stickers or temporary tattoos. The Examiner argues that it would have been obvious to include such materials, "since such a modification would add greater versatility to the activity kit." Appellants respectfully disagree, on the grounds that the underlying combination of references is without foundation, and there is no teaching or suggestion from the prior art to add these materials to any of the kits described in the cited prior art. There is no foundation other than the Examiner's opinion, that "such a modification would add greater versatility." Accordingly, *prima facie* obviousness has not been established.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

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Date: August 7, 2006

Respectfully submitted,

By: _____

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APPENDIX A**CLAIMS ON APPEAL**

1. An activity kit, comprising:
a box for holding a set of writing implements or other materials including rubber stamps, ink pads, playing cards or flash cards, stickers or temporary tattoos;
the box having front, back and side panels defining two front edges and two back edges; and
a pad of paper or book having a separate back panel hinged to the box in a manner allowing the pad or book and box to fold against one another in overlying registration.
2. The activity kit of claim 1, wherein the box and pad or book are generally of the same peripheral dimensions.
3. The activity kit of claim 1, wherein the writing implements are differently colored markers, crayons, or pencils.
4. The activity kit of claim 1, wherein the writing implements are of the color-changing type.
6. The activity kit of claim 1, wherein the pad of paper or book includes a coloring book, activity book, games, or puzzles.
7. The activity kit of claim 1, further including a fastener for holding the pad and box together when folded against one another.
8. The activity kit of claim 1, wherein the fastener is a snap or magnetic/hook-and-loop tab.
9. The activity kit of claim 1, further including handle on one or both of the box and back panel of the pad.

10. The activity kit of claim 1, including handles on both the box and back panel of the pad or book, each handle having a through-hole which is aligned with the other when folded against one another in overlying registration.

11. The activity kit of claim 1, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the back edges of the box so that the box and pad are side by side when unfolded.

12. The activity kit of claim 1, wherein the pad or book further includes a cover with a tab for holding the pad or book and box together when folded against one another.

13. The activity kit of claim 12, wherein the tab is located on the bottom of the cover.

14. The activity kit of claim 1, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the front edges of the box.

15. The activity kit of claim 1, wherein the pad or book includes a cover with a tab for holding the pad and box together when folded against one another.

16. An activity kit, comprising:
a box for holding a set of writing implements or other materials; and
a pad of paper or book including preprinted indicia in the form of a coloring book, activity book, games, or puzzles, the pad or book having a back panel hinged to the box in a manner allowing the pad or book and box to fold against one another in overlying registration.

17. The activity kit of claim 16, wherein the box and pad or book are generally of the same

peripheral dimensions.

18. The activity kit of claim 16, wherein the writing implements are differently colored markers, crayons, or pencils.

19. The activity kit of claim 16, wherein the writing implements are of the color-changing type.

20. The activity kit of claim 16, wherein the other materials include rubber stamps, ink pads, playing cards or flash cards, stickers or temporary tattoos.

21. The activity kit of claim 16, further including a fastener for holding the pad and box together when folded against one another.

22. The activity kit of claim 16, wherein the fastener is a snap or magnetic/hook-and-loop tab.

23. The activity kit of claim 16, further including handle on one or both of the box and back panel of the pad.

24. The activity kit of claim 16, including handles on both the box and back panel of the pad or book, each handle having a through-hole which is aligned with the other when folded against one another in overlying registration.

25. The activity kit of claim 16, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the back edges of the box so that the box and pad are side by side when unfolded.

26. The activity kit of claim 16, wherein the pad or book further includes a cover with a tab for holding the pad or book and box together when folded against one another.

27. The activity kit of claim 26, wherein the tab is located on the bottom of the cover.

28. The activity kit of claim 16, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the front edges of the box.

29. The activity kit of claim 16, wherein the pad or book includes a cover with a tab for holding the pad and box together when folded against one another.

30. An activity kit, comprising:
a box for holding a set of writing implements or other materials;
a pad of paper or book having a back panel hinged to the box in a manner allowing the pad and box to fold against one another in overlying registration; and
a handle on one or both of the box and back panel of the pad.

31. The activity kit of claim 30, wherein the box and pad or book are generally of the same peripheral dimensions.

32. The activity kit of claim 30, wherein the writing implements are differently colored markers, crayons, or pencils.

33. The activity kit of claim 30, wherein the writing implements are of the color-changing type.

34. The activity kit of claim 30, wherein the other materials include rubber stamps, ink pads, playing cards or flash cards, stickers or temporary tattoos.

35. The activity kit of claim 30, wherein the pad of paper or book includes a coloring book, activity book, games, or puzzles.

36. The activity kit of claim 30, further including a fastener for holding the pad and box together when folded against one another.

37. The activity kit of claim 30, wherein the fastener is a snap or magnetic/hook-and-loop tab.

38. The activity kit of claim 30, including handles on both the box and back panel of the pad or book, each handle having a through-hole which is aligned with the other when folded against one another in overlying registration.

39. The activity kit of claim 30, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the back edges of the box so that the box and pad are side by side when unfolded.

40. The activity kit of claim 30, wherein the pad or book further includes a cover with a tab for holding the pad or book and box together when folded against one another.

41. The activity kit of claim 40, wherein the tab is located on the bottom of the cover.

42. The activity kit of claim 30, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the front edges of the box.

43. The activity kit of claim 30, wherein the pad or book includes a cover with a tab for

holding the pad and box together when folded against one another.

44. An activity kit, comprising:
 - a box for holding a set of writing implements or other materials;
 - a pad of paper or book having a back panel hinged to the box in a manner allowing the pad and box to fold against one another in overlying registration; and
 - handles on both the box and back panel of the pad or book, each handle having a through-hole which is aligned with the other when folded against one another in overlying registration.
45. The activity kit of claim 44, wherein the box and pad or book are generally of the same dimensions.
46. The activity kit of claim 44, wherein the writing implements are differently colored markers, crayons, or pencils.
47. The activity kit of claim 44, wherein the writing implements are of the color-changing type.
48. The activity kit of claim 44, wherein the other materials include rubber stamps, ink pads, playing cards or flash cards, stickers or temporary tattoos.
49. The activity kit of claim 44, wherein the pad of paper or book includes a coloring book, activity book, games, or puzzles.
50. The activity kit of claim 1, further including a fastener for holding the pad and box together when folded against one another.
51. The activity kit of claim 1, wherein the fastener is a snap or magnetic/hook-and-loop tab.

52. The activity kit of claim 44, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the back edges of the box so that the box and pad are side by side when unfolded.

53. The activity kit of claim 44, wherein the pad or book further includes a cover with a tab for holding the pad or book and box together when folded against one another.

54. The activity kit of claim 53, wherein the tab is located on the bottom of the cover.

55. The activity kit of claim 44, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the front edges of the box.

56. The activity kit of claim 44, wherein the pad or book includes a cover with a tab for holding the pad and box together when folded against one another.

57. An activity kit, comprising:
a box for holding a set of writing implements or other materials, the box having front, back and side panels defining two front edges and two back edges; and
a pad of paper or book having a back panel hinged to one of the back or front edges of the box such that the box and pad are side by side when unfolded.

58. The activity kit of claim 57, wherein the front and back panel of the box and the back panel of the pad or book are generally of the same dimensions.

59. The activity kit of claim 57, wherein the writing implements are differently colored markers, crayons, or pencils.

60. The activity kit of claim 57, wherein the writing implements are of the color-changing type.

61. The activity kit of claim 57, wherein the other materials include rubber stamps, ink pads, playing cards or flash cards, stickers or temporary tattoos.

62. The activity kit of claim 1, wherein the pad of paper or book includes a coloring book, activity book, games, or puzzles.

63. The activity kit of claim 57, further including a fastener for holding the pad and box together when folded against one another.

64. The activity kit of claim 57, wherein the fastener is a snap or magnetic/hook-and-loop tab.

65. The activity kit of claim 57, further including handle on one or both of the box and back panel of the pad.

66. The activity kit of claim 57, including handles on both the box and back panel of the pad or book, each handle having a through-hole which is aligned with the other when folded against one another in overlying registration.

67. The activity kit of claim 57, wherein:
the box has front, back and side panels defining two front edges and two back edges; and
the back panel of the pad or book is hinged to one of the back edges of the box so that the box and pad are side by side when unfolded.

68. The activity kit of claim 57, wherein the pad or book further includes a cover with a tab for holding the pad or book and box together when folded against one another.

69. The activity kit of claim 68, wherein the tab is located on the bottom of the cover.
70. The activity kit of claim 57, wherein the pad or book includes a cover with a tab for holding the pad and box together when folded against one another.
71. The activity kit of claim 70, wherein the tab is situated on the side of the cover.
72. The activity kit of claim 57, wherein the box further includes a closable flap.

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None.

APPENDIX B

EVIDENCE

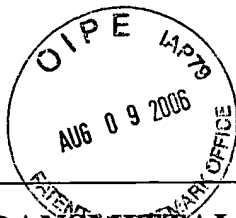
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APPENDIX C
RELATED PROCEEDINGS

None.

**TRANSMITTAL OF APPEAL BRIEF**Docket No.
GUP-10102/29

In re Application of: Joshua Pokempner et al.

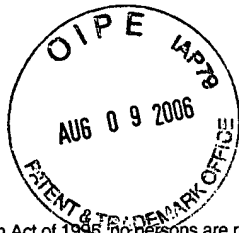
Application No.
10/733,828-Conf. #2198Filing Date
December 11, 2003Examiner
U. M. CegielnikGroup Art Unit
3711

Invention: ACTIVITY KIT, PARTICULARLY FOR CHILDREN AND YOUNG ADULTS

TO THE COMMISSIONER OF PATENTS:Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal
filed: June 7, 2006 .The fee for filing this Appeal Brief is \$ 250.00 .☐ Large Entity☒ Small Entity☐ A petition for extension of time is also enclosed.

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Application No. (if known): 10/733,828

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